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10/591,517	07/20/2007	Iain Mackenzie Mackcod	077164-0014	1664
1923 7590 09/01/2009 MCDERMOTT, WILL & EMERY LLP Attn: IP Department 227 WEST MONROE STREET SUITE 4400 CHICAGO, IL 60606-5096			EXAMINER SADLON, JOSEPH	
			ART UNIT 3633	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/591,517

**Applicant(s)**

MACLEOD ET AL.

**Examiner**

JOSEPH J. SADLON

**Art Unit**

3633

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 July 2007 and 05 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 18-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 September 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statements(s) (PTO/SB08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Paper No(s)/Mail Date \_\_\_\_\_
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This communication is a First Office Action on the Merits. Claims 1-17, as originally filed, are pending and have been considered as follows:

#### ***Election/Restrictions***

Applicant's election with traverse of "Group I, at least claims 1-17" and "Species II, which includes claims 1-21" in the reply filed on 05/05/09 is acknowledged.

The traversal is on the ground(s) that both inventions refer to the same special technical feature of the reinforcing member.

This argument is not found persuasive because:

a. The Groups as presented by the examiner comprised different special technical features: one Group relating to panels reinforced with an internally housed member arranged to resist forces experienced normal to the vertical plane; one Group relating to wall modules constructed of interlocking panels; one Group relating to a method of enabling panels received in columns to be individually raised. These Groups all comprise different inventive steps and are unrelated to the reinforcing member, as Argued.

b. The Species as presented by the examiner for restriction comprised different special technical features relating to the length and size of the glazing relating to the panel members. Like the Groups mentioned above, the Species each comprise different inventive steps and are unrelated to the reinforcing member, as Argued.

The requirement is still deemed proper and is therefore made FINAL.

Claims 18-21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 05/05/09.

### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description:

- (1) reference numeral "6".

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be

notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are also objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the

(1) "at least one bracket located and retained in slot for attaching a member to the wall" (claim 12, line 1-2)

must be shown or the feature(s) canceled from the claim(s). Neither "at least one bracket" or "a member" have been shown in the drawings. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

Claim 12 is objected to because of the following informalities:

The recitation "retained in slot" appears to be grammatically incorrect, and should be replaced by --retained in a slot-- (see Claim Rejections below).

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claim 11-13 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 11, line 2 (of claims as appearing in Preliminary Amendment filed 01 September 2006), the recitation of "wherein panel members are" is vague, indefinite, and confusing as lacking antecedent basis. Which "panel members" are provided with a longitudinal slot that can be used to attach a member? Are the "panel members" of claim 8 provided with such a slot, or are heretofore unclaimed additional panel members introduced that are provided with such a slot in at least one side wall?

Claim 12, line 2, the recitation of "retained in slot" is vague, indefinite, and confusing as lacking antecedent basis. If "slot" is referring back to "a longitudinal slot" introduced in claim 11, then "retained in slot" should be changed to –retained in the slot--.

Claim 13, line 2, the recitation of "further comprising glazing located in the wall" is vague, indefinite, and confusing as not being clear. Does Applicant mean –a glazing--?

Claim 15, lines 1-2, the recitation of "wherein the glazing members are formed by part of a panel member" is vague, indefinite, and confusing as not being clear because the recitation of "a panel member" lacks antecedent basis. Is "a panel member" referring back to one of the plurality of panel members introduced in claim 1 or is it introducing an additional panel member?

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1, 6-10, 16-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Burt (U.S. 6,295,778).**

**As per claim 1**, Burt teaches a plurality of elongate panel members (exterior wall panels 30, FIG. 1) arranged to extend horizontally between a pair of upright support members (fastening panel 40, FIG. 1) wherein the panel members are stacked one on

top of another in a vertical plane to form a wall of a desired height, wherein panel members are formed with at least one internal longitudinal chamber (hollow 130A, FIG. 6; note "first embodiment" col. 2, ln. 18), wherein at least some of the panel members are provided ("may be inserted", col. 4, ln. 15) with an elongate reinforcing member (reinforcement material 132A, FIG. 6) extending lengthwise of the chamber ("throughout the length" col. 4, ln. 17), and wherein the reinforcing member are constructed and arranged to have a higher resistance (maximum reinforcement) to forces applied in a direction (C) normal to the vertical plane of the wall than parallel to the vertical plane of the wall.

**As per claim 6**, Burt teaches the panel members are made of plastics material (col. 1, ln. 54-60).

**As per claim 7**, Burt teaches the panel members are plastics extrusions (col. 10, ln. 44-46).

**As per claim 8**, Burt teaches the panel members are of generally hollow rectangular section (see FIG. 6) with spaced parallel side walls and longitudinally extending edge formations (bottom side 33A, a top side 34A) that co-operate to locate adjacent panel members relative to each other on assembly of the wall.

**As per claim 9**, Burt teaches each panel member is provided with mating tongue and groove formations (receptacle 31A, protrusion 32A, FIG. 6) on opposed edges.

**As per claim 10**, Burt teaches the the panel members are divided internally into a plurality of chambers (hollows 130A, FIG. 6) by one or more partition walls (see FIG. 6; note transverse walls) extending between the side walls.

**As per claim 16**, Burt teaches the support members (fastening panel 40, FIG. 1) are adapted for inserting (see "adapted to receive") the panel members one-by-one between the support members ("method for inserting an edge" col. 6, ln. 4-8) at a lower end thereof and raising the panel members to allow a next panel member to be inserted until the desired height of the wall is achieved.

**As per claim 17**, Burt teaches the end portions of the panel members are received (see "slides" col. 6, ln. 7) in vertical channels (groove 42A, FIG.22) of the support members .

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burt in view of Wycech (U.S. 6,341,467).**

**As per claim 2**, Burt teaches the limitations of claim 1, but fails to explicitly disclose each reinforcing member comprises a plurality of generally parallel plates connected by webs whereby the reinforcing member is of increased strength in a plane (A) substantially parallel to the plates than at right angles (B) thereto.

Wycech (U.S. 6,341,467) teaches a reinforcement for hollow structures (title) wherein a roll formed metal reinforcing insert (col. 6, ln. ln. 59-61) comprises:

a plurality of generally parallel plates (fold regions 70, FIG. 6) connected by webs whereby the reinforcing member is of increased strength in a plane (A) substantially parallel to the plates than at right angles (B) thereto.

From this teaching, it would have been obvious to one of ordinary skill in the art of wall construction at the time the invention was made to supplement the reinforcing material in the hollows of Burt with the reinforcing insert of Wycech for the purpose of providing increased reinforcement.

**As per claim 3**, Burt as modified by Wycech teaches the limitations of claim 2. Wycech further discloses each reinforcing member is arranged so that plates extend generally parallel to a plane (A) normal to the vertical plane of the wall (note it is recognized that the reinforcing inserts can be disposed at any angle; see FIG. 6).

**As per claim 4**, Burt as modified by Wycech teaches the limitations of claim 2. Wycech further discloses each reinforcing member is of approximately W-shape in transverse section (note principal surfaces 44 and 46, FIG. 6 approximate a W-shape; see also "plates being interconnected" col. 3, ln. 2).

**As per claim 5**, Burt as modified by Wycech teaches the limitations of claim 2. Wycech further discloses each reinforcing member is made of rolled sheet metal (see "roll formed metal" col. 6, ln. 61).

**Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burt in view of Weir (U. S. 5,247,773).**

**As per claim 11**, Burt teaches the limitations of claim 8, but fails to explicitly disclose panel members are provided with a longitudinal slot in at least one side wall that can be used to attach a member to the wall.

Weir teaches a building structures (title) wherein panel members are provided with a longitudinal slot (female locking structure 12, FIG. 18) in at least one side wall that can be used to attach a member (decorative mullion 129, FIG. 19) to the wall.

From this teaching, it would have been obvious to one of ordinary skill in the art to include the slot and bracket and mullion of Weir with the wall panels of Burt for decorative purposes.

**As per claim 12**, Burt as modified by Weir teaches the limitations of claim 11.

Weir further teaches at least one bracket (male locking structure 11, FIG. 19) located and retained in slot for attaching a member to the wall.

**Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burt in view of McDonald et al. (U.S. 6,513,288).**

**As per claim 13**, Burt teaches the limitations of claim 8, but fails to explicitly disclose glazing located in the wall.

McDonald et al. teaches window assembly for partitions (title) which includes glazing (window assembly 1, FIG. 2) located in the wall.

From this teaching, it would have been obvious to one of ordinary skill in the art to include the window assembly of McDonald et al. amongst the wall panels of Burt for the purpose of providing ventilation and light within the modular building structure.

**As per claim 14**, Burt as modified by McDonald teaches the limitations of claim 13. McDonald further teaches the glazing is located by glazing members (side brackets 6, channel member 25, FIG. 2) arranged to extend above and below a glazing panel (glass sheet 3, FIG. 2) with the glazing members (6,25, FIG. 2) adapted to co-operate ("allow horizontal shifting" col. 4, ln. 62-63) with edge formations (opening 16, FIG. 1) of adjacent panel members.

**As per claim 15**, Burt as modified by McDonald teaches the limitations of claim 14. McDonald further teaches the glazing members are formed by part of a panel member (see FIG. 5; note channel member 25 is attached to and thereby formed by part of panel the lower panel members, denoted 2).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. 5,477,646 to Dietz et al. teaches a plurality of interlocking panels received within channels of vertical supports.

U.S. 2,963,825 to Douglas, Jr. teaches a prefabricated house construction wherein a glazed wall cooperates with adjacent panels.

U.S. 3,173,179 to Edwards teaches a metal window construction.

U.S. 7,040,373 to Snyder teaches a door panel wherein extruded interlocking panel members exhibit T-slot receive mating protrusions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSEPH J. SADLON whose telephone number is (571)270-5730. The examiner can normally be reached on M-F 7:30A-5:00P/Alt. Fri. Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gay Ann Spahn can be reached on (571)272-7731. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Gay Ann Spahn/

Gay Ann Spahn, Primary Examiner

August 30, 2009

/J. J. S./

Joseph J. Sadlon

Examiner, Art Unit 3633